



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,737	08/27/2001	Cheng-Hao Chou	2760-15	5143

616 7590 01/30/2006

THE MAXHAM FIRM
750 "B" STREET, SUITE 3100
SAN DIEGO, CA 92101

EXAMINER

VO, NGUYEN THANH

ART UNIT PAPER NUMBER

2685

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,737

Applicant(s)

CHOU, CHENG-HAO

Examiner

Nguyen T. Vo

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10, 18-23 and 29-56 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 18-23 and 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/27/2005 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 33-45, 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasnier (6,504,932) in view of Japanese document 63-168755 (previously cited) and Desblancs (6,456,859, newly cited by examiner).

As to claim 33, Vasnier discloses a SIM card system having memory 23 (see figure 2) for storing digital data; a processor 21 coupled to the memory 23; a connector 211 for holding and connecting to a first SIM card (see column 3 lines 50-55); an input means 29 for inputting instructions to the processor (see column 5 lines 29-31); a power supply (inherently included in order to supply power to the components of the mobile station); a displayer 28 for displaying the data (see column 5 lines 36-40). Vasnier fails

to disclose that the SIM card system is a SIM card backup system, wherein the processor restores the data to a second SIM card according to the inputting instructions as claimed. Japanese document discloses memory card backup system (see the English translation). The backup system comprises a memory for reading, writing and storing results in access times (see the memory in the holder). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of the Japanese document to Vasnier, in order to obtain a reliable memory backup for the SIM card (as suggested by the Japanese document).

Still as to claim 33, the combination of Vasnier and the Japanese document fails to disclose displaying data transferred from the first SIM card as claimed. Desblancs discloses displaying data transferred from a SIM card (see column 3 lines 37-43). Desblancs further discloses a SIM card system having memory (see column 2 lines 55-60) for storing digital data; a processor 11; a connector 6 for holding and connecting to a SIM card 3; an input means 7 for inputting instructions to the processor (see column 3 lines 23-37); a power supply 22; and a displayer 2 for displaying the data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Desblancs to the combination of Vasnier and the Japanese document, in order to allow the user to view the data read from the SIM card (as suggested by Desblancs at column 3 lines 37-43).

As to claims 34-35, 42-43, 52-53, the combination of Vasnier and Japanese document and Desblancs does disclose a memory 23 (see Vasnier). The above

combination, however, fails to disclose that the memory comprises a flash memory, or a EEPROM.

As to claims 36-37, 44-45, 54-55, the combination of Vasnier and Japanese document and Desblancs does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a LED as claimed.

The examiner, however, takes Official Notice that a flash memory, EEPROM, LCD display and LED display are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claims 38, 56, Vasnier discloses a keypad 29 (see figure 2).

As to claim 39, it is rejected for the same reasons as set forth in claim 33 above. In addition, Vasnier does disclose a communication device with a communication module as claimed (see the cellular telephone in figure 2).

As to claims 40-41, Vasnier discloses the communication device is a mobile telephone (see column 1 lines 9-13; column 2 lines 45-51 and lines 61-64).

As to claim 51, it is rejected for the same reasons as set forth in claim 33 above. In addition, the combination of Vasnier and Japanese document and Desblancs discloses a backup program (see Japanese document).

4. Claims 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasnier (6,353,737) in view of Japanese document 63-168755 and Desblancs (6,456,859) and Erola (6,092,133).

As to claim 46, first of all the rejection to claim 33 above over the combination of Vasnier and Japanese document and Desblancs is hereby incorporated. In addition, the above combination discloses using the SIM backup system in a mobile telephone instead of a PDA as claimed. Erola discloses SIM card can be used in a mobile telephone or a PDA (see column 11 lines 6-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the SIM card backup system in Erola, in order to obtain a multi-purpose mobile communication device (as suggested by Erola at column 11 lines 6-17).

As to claim 47, the combination of Vasnier and Japanese document and Desblancs and Erola does disclose a memory 23 (see Vasnier). The above combination, however, fails to disclose that the memory comprises a flash memory as claimed.

As to claims 48, 50, the combination of Vasnier and Japanese document and Desblancs and Erola does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a touch screen panel as claimed.

The examiner, however, takes Official Notice that a flash memory, LCD display and touch screen panel are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the invention of

the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claim 49, Vasnier discloses a keypad 29 (see figure 2).

5. Claims 33-45, 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarskog (WO 01/62029 A1) in view of Vasnier (6,504,932) and Desblancs (6,456,859, newly cited by examiner).

As to claim 33, Sarskog discloses a back up system (see figure 1) comprising a memory (see memory 5, 7); a processor; an input means; a power supply; a displayer (all inherently included in the computer 4, 6). Sarskog further discloses restoring the data to a second SIM card according to the inputting instruction as claimed (see page 1 line 31 to page 2 line 6; page 3 line 24 to page 4 line 4). Sarskog thus discloses all the claimed limitations except that the data transferred to and from the SIM cards via wireless medium, instead of via a connector for holding and connecting the SIM cards as claimed. Vasnier discloses a SIM card system having memory 23 (see figure 2) for storing digital data; a processor 21 coupled to the memory 23; a connector 211 for holding and connecting to a first SIM card (see column 3 lines 50-55); an input means 29 for inputting instructions to the processor (see column 5 lines 29-31); a power supply (inherently included in order to supply power to the components of the mobile station); a displayer 28 for displaying the data (see column 5 lines 36-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

provide the above teaching of Vasnier to Sarskog, so that data transferred from and to the SIM cards could be protected by encryption (as suggested by Vasnier).

Still as to claim 33, the combination of Sarskog and Vasnier fails to disclose displaying data transferred from the first SIM card as claimed. Desblancs discloses displaying data transferred from a SIM card (see column 3 lines 37-43). Desblancs further discloses a SIM card system having memory (see column 2 lines 55-60) for storing digital data; a processor 11; a connector 6 for holding and connecting to a SIM card 3; an input means 7 for inputting instructions to the processor (see column 3 lines 23-37); a power supply 22; and a displayer 2 for displaying the data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Desblancs to the combination of Sarskog and Vasnier, in order to allow the user to view the data read from the SIM card (as suggested by Desblancs at column 3 lines 37-43).

As to claims 34-35, 42-43, 52-53, the combination of Sarskog and Vasnier and Desblancs does disclose a memory 23 (see Vasnier). The above combination, however, fails to disclose that the memory comprises a flash memory, or a EEPROM.

As to claims 36-37, 44-45, 54-55, the combination of Sarskog and Vasnier and Desblancs does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a LED as claimed.

The examiner, however, takes Official Notice that a flash memory, EEPROM, LCD display and LED display are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the

invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claims 38, 56, Vasnier discloses a keypad 29 (see figure 2).

As to claim 39, it is rejected for the same reasons as set forth in claim 33 above. In addition, Vasnier does disclose a communication device with a communication module as claimed (see the cellular telephone in figure 2).

As to claims 40-41, Vasnier discloses the communication device is a mobile telephone (see column 1 lines 9-13; column 2 lines 45-51 and lines 61-64).

As to claim 51, it is rejected for the same reasons as set forth in claim 33 above. In addition, the combination of Sarskog and Vasnier and Desblancs discloses a backup program (see the backup program in Sarskog).

6. Claims 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarskog (WO 01/62029 A1) in view of Vasnier (6,353,737) and Desblancs and Erola (6,092,133).

As to claim 46, first of all the rejection to claim 33 above over the combination of Sarskog and Vasnier and Desblancs is hereby incorporated. In addition, the above combination discloses using the SIM backup system in a mobile telephone instead of a PDA as claimed. Erola discloses SIM card can be used in a mobile telephone or a PDA (see column 11 lines 6-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the SIM card backup system in

Art Unit: 2685

Erola, in order to obtain a multi-purpose mobile communication device (as suggested by Erola at column 11 lines 6-17).

As to claim 47, the combination of Sarskog, Vasnier and Desblancs and Erola does disclose a memory 23 (see Vasnier). The above combination, however, fails to disclose that the memory comprises a flash memory as claimed.

As to claims 48, 50, the combination of Sarskog, Vasnier and Desblancs and Erola does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a touch screen panel as claimed.

The examiner, however, takes Official Notice that a flash memory, LCD display and touch screen panel are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claim 49, Vasnier discloses a keypad 29 (see figure 2).

Response to Arguments

7. Applicant's arguments with respect to claims 33-56 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Document DE 10146664 A1 discloses back-up memory for use in radiotelephone.

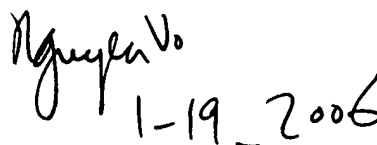
Japanese document 2001-186556 discloses transferring data between two memory cards (see the previously cited US 2002/0160808 A1 for English translation).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T. Vo whose telephone number is (571) 272-7901. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen Vo



NGUYEN T. VO
PRIMARY EXAMINER